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Date: August 14, 2006

/Jessica Sexton/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicants: Curtis G. Wong *et al.*

Examiner: Son P. Huynh

Serial No: 09/650,375

Art Unit: 2623

Filing Date: August 29, 2000

Title: SYSTEM AND METHOD FOR PROVIDING PROGRAM CRITERIA
REPRESENTING AUDIO AND/OR VISUAL PROGRAMMING

**Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

REPLY BRIEF

Dear Sir:

Appellants' representative submits this Reply Brief in response to the Examiner's Answer dated June 15, 2006. The credit card payment form is believed to cover all fees due regarding this document. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP131US].

REMARKS

Claims 1-67 are currently pending and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein. In particular, the following comments address deficiencies contended in the Examiner's Answer to appellants' Appeal Brief.

I. Regarding the Rejection of Claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 Under 35 U.S.C. §102(a)

The Examiner incorrectly maintains the rejection of claims 1-11, 24, 25, 27-36, 38-49, 51-57 and 59-66 under 35 U.S.C. §102(a) as being anticipated by Ellis *et al.* (WO 00/04709). Appellants' representative respectfully requests that this rejection be reversed for at least the following reasons. Ellis *et al.* fails to disclose all limitations of the subject claims.

A single prior art reference anticipates a patent claim only if it expressly or inherently describes *each and every limitation* set forth in the patent claim. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). *The identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added).

The claimed invention relates to a system for providing program criteria to facilitate recording of a specific audio and/or visual program. In particular, independent claims 1, 24, 30, 32, 40, 42, 44, 46, 51 and 59 recite similar limitations, namely *a server computer storing a plurality of tokens, each token having a system unique identifier for identifying a predetermined at least one of an audio and visual program; wherein the server is programmed to provide at least one token to a remote computer based on received selection criteria.* More particularly, for example, the claimed invention can provide a host computer of a media program that can make available to a user (*e.g.*, employing e-mail) a token for transmitting to one or more recording devices; and the token can contain all necessary information to effect recording of the media by the one or more recording devices that receive the token. Ellis *et al.* is silent regarding such novel aspects of the claimed invention.

On page 29 of the Examiner's Answer, the Examiner incorrectly equates program guide features taught by Ellis *et al.* to the token afforded by the claimed invention. One cannot simply transmit a programming guide feature to a recording device to effect recording of a desired program. Rather, a user makes a selection based on programming guide features, and the selections are subsequently communicated to a recording device to allow for a desired program to be recorded. Thus, program guide features cannot simply be transmitted to a recording system to achieve programming thereof as facilitated by the token of the claimed invention. Rather, Ellis *et al.* communicates user selections based on the program guide features to the recording system without teaching that such communications are transmitted to the recording system in a single component such as the token of the claimed invention.

What is more, the cited reference does not *use stored programming information and user information to construct a token that includes information sufficient to program a recording system to record at least one of audio and visual content*, as recited by independent claim 59. As noted above, the Examiner incorrectly equates program guide features taught by Ellis *et al.* with the token of the claimed invention. Program guide features taught by Ellis *et al.* are not constructed based on stored programming and user information. To the contrary, program guide features merely represent program characteristics that are displayed to a user, and the user selects desired content based on the program guide features. Therefore, the cited reference does not construct any single component such as a token that is sufficient to program a recording system to record audio or visual content. Instead, Ellis *et al.* transmits user-made selections based on the program guide features to a recording system to record a desired program without contemplating constructing and utilizing a single component such as the token of the claimed invention to transmit such data.

In view of at least the foregoing, it is readily apparent that Ellis *et al.* does not disclose the identical invention in as complete detail as is contained in the subject claims. Accordingly, this rejection should be reversed.

II. Regarding the Rejection of Claims 15-21, 50, 58 and 67 Under 35 U.S.C. §103(a)

The Examiner incorrectly maintains the rejection of claims 15-21, 50, 58 and 67 under U.S.C. §103(a) as being unpatentable over Ellis *et al.* Reversal of this rejection is respectfully requested for at least the following reasons. The subject claims depend from independent claims

1, 46, 51 and 59. As noted above, Ellis *et al.* fails to disclose all features of the subject independent claims. Therefore, this rejection should be reversed.

III. Regarding the Rejection of Claims 12-14, 22, 23, 26 and 37 Under 35 U.S.C. §103(a)

The rejection of claims 12-14, 22, 23, 26 and 37 have been incorrectly maintained by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Ellis *et al.* in view of Knudson *et al.* (US 6,536,041). This rejection should be reversed for at least the following reasons. The subject claims respectively depend from independent claims 1, 15, 24 and 32. As noted above, Ellis *et al.* does not teach or suggest all features of these independent claims; and Knudson *et al.* does not make up for such deficiencies of Ellis *et al.* Accordingly, this rejection should be reversed.

IV. Conclusion

The subject application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP131US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact appellants' undersigned representative at the telephone number below.

Respectfully submitted,
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